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May 7, 2001

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Director of Technology Center 3600
Commissioner for Patents
Washington, D.C. 20231

Re: Application Serial No.: 09/086,857
Appellant: David T. Frederick, et al.
Title: System For Tracking And Dispensing
Medical Items From Environmentally
Controlled Storage Area
Docket No.: D-1093

Sir:

Please find enclosed a Petition pursuant to 37 C.F.R. § 1.181 for Withdrawal of Holding of Noncompliance with 37 CFR § 1.192(c) for filing in the above case.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with the filing of the Petition, and any other fee due, to Deposit Account 04-1077.

Very truly yours,

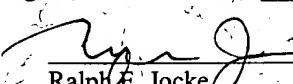

Ralph E. Jocke

Reg. No. 31,029

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this document and the documents indicated as enclosed herewith are being deposited with the U.S. Postal Service as Express Mail Post Office to addressee in an envelope addressed to Director of Technology Center 3600, Commissioner for Patents, Washington, D.C. 20231 this 7th day of May 2001.

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D-1093



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **David T. Frederick, et al.**)
Serial No.: **09/086,857**) Art Unit 3651
Filed: **May 29, 1998**) Patent Examiner:
Title: **System For Tracking And Dispensing**) Michael E. Butler
Medical Items From Environmentally)
Controlled Storage Area)

Director of Technology Center 3600
Commissioner for Patents
Washington, D.C. 20231

Sir:

Appellants received a Notification of noncompliance with 37 C.F.R. § 1.192(c) dated April 9, 2001. A Supplemental Appeal Brief was submitted in response thereto. Hence, the following petition may be moot in view of a finding of the Supplemental Appeal Brief being in compliance with 37 C.F.R. § 1.192(c). Furthermore, if a request for reconsideration is first required, then this petition should be considered as such.

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**Petition For Withdrawal of Holding of Noncompliance
With 37 C.F.R. § 1.192(c)**

Appellants respectfully petition against the holding of noncompliance with 37 C.F.R. § 1.192(c) dated April 9, 2001. Appellants respectfully petition for the withdrawal of the holding of noncompliance. Appellants' Brief was asserted by the Examiner to be defective because it exceeded a brief size limit. That is, the Brief was held to exceed an alleged 30-page, 14,000 words, or 1,300 lines limitation. The Appellants maintain that this is not a legal basis for holding the Brief in noncompliance with 37 C.F.R. § 1.192(c).

The Notification of noncompliance dated April 9, 2001 ("Notification") asserts that the PTO is an administrative agency, and because of the Administrative Procedures Act unless a statute on point or an agency promulgated rule on point exists, then the Federal Rules of Evidence and Federal Rules of Appellate Procedure apply.

That erroneous assertion was purportedly based on 5 U.S.C. § 559, which is part of the Administrative Procedure Act. However, that statute does not state that the Federal Rules of Evidence and Appellate Procedure apply to Federal agencies if there is not a specific agency rule on the matter. A copy of 5 U.S.C. § 559 is attached hereto. The specific part of the Statute misquoted by the Examiner, states "Except as otherwise required by law, requirements or privileges relating to evidence or procedure apply equally to agencies and persons."

The Statute provides that Due Process applies equally to agencies and people. It does not imply that the Federal Rules of Appellate Procedure, let alone the brief page limit in such Rules, applies to appeals to the Board of Patent Appeals and Interferences.

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The few cases that have mentioned the cited Statute (or its predecessor, 5 U.S.C.A. § 1011) have considered issues related to Due Process, such as whether certain documents had to be made available before an administrative hearing was held, what steps needed to be followed before a new Indian reservation was created and what standard should be used to evaluate the agency's decisions. Sperry and Hutchinson Co. v. F.T.C., 256 F. Supp. 136, 143; U.S. v. Libby, McNeil & Libby, 107 F. Supp. 697, 703. Similarly, in Dickinson v. Zurko, No. 98-377, 527 U.S. 150 (1999) the courts were concerned with issues of Due Process, not the Federal Rules of Evidence or the Federal Rules of Appellate Procedure.

Zurko is an appeal of a U.S. Patent Office decision. Id. However the decision in Zurko does not in any way hold or imply that the Federal Rules of Appellate Procedure are applicable to appeals before the Board of Patent Appeals and Interferences. The United States Supreme Court only decided the standard of review for a patent appeal in the Federal Circuit Court of Appeals. Id. The Examiner incorrectly cited the case in attempting to make an argument for which there is absolutely no legal support.

Rule 1 of the Federal Rules of Appellate Procedure states, "These rules govern procedure in the United States courts of appeals." It does not say that the Federal Rules of Appellate Procedure apply to the agencies of the U.S. Government.

Contrary to the Examiner's assertion the courts have stated that absent an express agency rule the Federal Rules of Evidence do not apply to administrative proceedings. U.S. Steel Mining Co., Inc. v. Director, Office of Workers' Compensation Programs, 187 F. 3d 384, 388 (4th Cir. 1999) and Peabody Coal Co. v. Director, Office of Workers' Compensation Programs, 165 F. 3d 1126, 1128-1129 (7th Cir. 1999). Similarly the Federal Rules of Appellate Procedure

also do not apply to administrative agencies, absent an express agency rule making such rules applicable. The U.S. Patent Office has no such rule.

The invalid conclusion of the Examiner is that unless there is a statute or agency promulgated rule on point, then the Federal Rules of Evidence and the Federal Rules of Appellate Procedure are applicable to administrative agencies. Appellants have shown that conclusion to be unsupported and courts have reached the exact opposite conclusion. However even if the Examiner's position were correct, there are rules promulgated by the Patent and Trademark Office that apply specifically to appeals before the Board of Appeals and Interferences. Because specific agency rules have been promulgated which have different provisions, the Federal Rules of Appellate Procedure do not apply to Appellants' Brief.

The Notification admits that "There is no statutory limit within Titles 35 or 5 of the Code or Title 37 of the Rules on brief size before the Board." The Appellants agree with the Examiner that there is no limit within the statutes, rules, or Office procedures concerning the length of a brief presented to the Board. Furthermore, it is respectfully submitted that an agency (PTO) promulgated rule directly on point already exists. MPEP § 1206 at page 1200-9 (Rev. 1. Feb. 2000) clearly states:

37 CFR 1.192(c) merely specifies the minimum requirements for a brief, and does not prohibit the inclusion of any other material which an appellant may consider necessary or desirable, for example, a list of references, table of contents, table of cases, etc. A brief is in compliance with 37 CFR 1.192(c) as long as it includes items (1) to (9) in the order set forth (with the appendix, item (9), at the end).

Appellants' Brief includes items (1) to (9). Thus, Appellants' Brief is in compliance with 37 C.F.R. § 1.192(c).

Further evidence that Appellants' Brief is in compliance with the PTO Rules may be obtained from the Notification itself. Box 1 on said Notification refers to a brief not containing the items (1) to (9). However, that box was not checked. Thus, the Office itself admits that Appellants' Brief contains items (1) to (9) and is in compliance with 37 C.F.R. § 1.192(c).

Furthermore, 37 C.F.R. § 1.192 requires that Appellants "must set forth the authorities and arguments on which appellant will rely to maintain the appeal" and "the brief shall contain the following items" (1) to (9). Attention is also directed to 37 C.F.R. § 1.111 and 37 C.F.R. § 1.113. It is noted that 37 C.F.R. § 1.111 requires a "reply to every ground of objection and rejection." To set a limit on the size of a brief would be in direct conflict with the requirements imposed on Appellants by the statutes and rules, including 37 C.F.R. § 1.192(a)(8) which requires Appellants to explain the errors in each rejection presented. In cases like the present appeal, thirty (30) pages is not sufficient to comply with the express requirements of 37 C.F.R. § 1.192 for all the pending claims and grounds for rejection.

Furthermore, an Appellants' representative spoke with Mr. Craig Feinberg (Administrator for Patent Appeals and Interferences) from the Board on April 17, 2001 concerning any rule on brief sizes. Mr. Feinberg assured Appellants' representative that he was unaware of any limitation on the size of a brief. The Board of Appeals and Interferences has received numerous briefs from Appellants' representative and others that exceed thirty (30) pages without objection.

Unless the Examiner can produce some legal authority with respect to limiting brief size, then it appears that the Examiner has clearly exceeded his bounds of authority. Not only did the

Examiner attempt to create his own new rules, but he further attempted to judge Appellants' Brief based on these self-created new rules. Nevertheless, Appellants have shown the Examiner's actions to be in clear error.

Furthermore, the Notification is not in compliance with the Office's own rules and procedures. Thus, the Notification is defective.

This Notification also violates Appellants' Constitutional rights. There is no limit on the number of claims which can be filed. Also, there is no limit on the number of different rejections that can be applied by the Office. Limiting the size of Appellants' Brief would prevent Appellants from being able to fully respond to all rejections in an (unlimited in size) Office Action. This would constitute a denial of Due Process.

Additionally, unless the Office is holding all appeal briefs to a specific (lower) size limit, (which it is not) then the Office's action against Appellants constitutes action which is arbitrary and capricious, and a violation of Appellants Due Process and Equal Protection rights.

Furthermore, the Appellants take exception to the statement in the Notification that "Applicant has misstated the status of claims 46-47" concerning Higham and Lavigne. The Advisory Action indicated, and the Notification confirmed, that the 35 U.S.C. § 102(b) rejection of claim 45 by Lavigne; the 35 U.S.C. § 102(e) rejection of claim 45 by Higham; the 35 U.S.C. § 103(a) rejection of claim 45 by Higham; and the 35 U.S.C. § 103(a) rejection of claim 45 by Lavigne in view of Aten were all withdrawn because of the effectiveness of the Declaration submitted by Appellants swearing behind the dates of Higham and Lavigne.

Claims 46 and 47 depend from independent claim 45. If independent claim 45 has overcome the references (Higham; Lavigne; Lavigne/Aten) as indicated, then surely the claims

(claims 46-47) which depend from claim 45 also overcome the indicated references. This aspect of patent prosecution is well known. The Examiner admits that the independent claim 45 is patentable over the indicated references, then how is it that claims 46 and 47 (which depend from patentable claim 45) are not also patentable over these same indicated references?

Thus, it is respectfully submitted that the allegation that the Brief does not present an argument for claims 46 and 47 with respect to the Higham, Lavigne, and Lavigne/Aten issues is without basis. Furthermore, the Office's requirement that Appellants respond to the rejections of claims 46 and 47 in regard to the indicated references is needless and only extends the length of the Brief. Hence, the holding of noncompliance should be withdrawn.

The holding of noncompliance should be withdrawn for the reasons presented herein. Furthermore, the holding of noncompliance should be withdrawn on the basis that (1) the Brief is already in full compliance with 37 C.F.R. § 1.192(c), and (2) the Notification is defective by not being in compliance with the Office's own procedures. Appellants respectfully request that their petition be granted.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,

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US Code as of: 01/23/00

Sec. 559. Effect on other laws; effect of subsequent statute

This subchapter, chapter 7, and sections 1305, 3105, 3344, 4301(2)(E), 5372, and 7521 of this title, and the provisions of section 5335(a)(B) of this title that relate to administrative law judges, do not limit or repeal additional requirements imposed by statute or otherwise recognized by law. Except as otherwise required by law, requirements or privileges relating to evidence or procedure apply equally to agencies and persons. Each agency is granted the authority necessary to comply with the requirements of this subchapter through the issuance of rules or otherwise. Subsequent statute may not be held to supersede or modify this subchapter, chapter 7, sections 1305, 3105, 3344, 4301(2)(E), 5372, or 7521 of this title, or the provisions of section 5335(a)(B) of this title that relate to administrative law judges, except to the extent that it does so expressly.

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